

The opinion in support of the decision being entered today (1) was **not** written for publication in a law journal and (2) is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL BUETTIKER

Appeal No. 1998-0484
Application No. 08/675465

ON BRIEF

Before ABRAMS, STAAB, and JENNIFER D. BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 11, which are all of the claims pending in this application, claims 2-10 having been canceled.

We REVERSE.

BACKGROUND

The appellant's invention relates to a molten glass feeder. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Barker, Jr. (Barker)	2,075,756	Mar. 30, 1937
Kirkman et al. (Kirkman)	4,305,747	Dec. 15, 1981

Claims 1 and 11 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 1 and 11 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Kirkman in view of Barker.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 17) and the final rejection (Paper No. 15) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 16) and Reply Brief (Paper No. 18) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, the applied prior art references, the respective positions articulated by the appellant and the examiner, and the guidance provided by our reviewing court. As a consequence of our review, we make the determinations which follow.

The Rejection Under 35 U.S.C. § 112, First Paragraph

The examiner has taken the position that the language of claim 1 which recites that the oblong lower outlet opening is located completely “within” the circular upper inlet opening is not supported by the disclosure, considering that the two openings are remote from each other.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). It would appear that the examiner believes the definition of “within” should be so limited as to require that the two openings be in the same plane which, of

course, is not the case in the appellant's disclosure. We do not agree. The appellant has disclosed that the two openings in the spout bowl are in planes spaced vertically from one another, as is shown in Figures 1 and 2. It is our view that one of ordinary skill in the art readily would have understood from the disclosure that describing the lower outlet opening as being "within" the upper inlet opening is intended to mean that it falls within the perimeter of the upper opening when viewed along the axis of the spout bowl, for example, looking down from the top, as in Figure 3.

This rejection is not sustained.

The Rejection Under 35 U.S.C. § 103

The examiner has taken the position that all of the subject matter recited in claim 1 is taught by Kirkman, except for the particular relationship between the shapes of the inlet and the outlet openings of the spout bowl. This, however, the examiner finds in Barker, concluding it would have been obvious to replace the arrangement of Kirkman with that of Barker.

The examiner bears the initial burden of presenting a prima facie case of obviousness when rejecting claims under 35 U.S.C. § 103. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art.

See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). It is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

It is our opinion that the examiner has not met these burdens, and we therefore will not sustain the rejection. Our rationale for arriving at this conclusion follows.

In column 1, Kirkman explains that in apparatus which produce multiple gobs of glass, control of the flow of the center streams has presented a problem due to the fact that they are hotter than the outer streams, as has maintaining uniformity of flow. The improvements offered in the Kirkman invention to overcome these problems include providing a relatively small circular inlet opening at the top of the spout bowl and an elongated outlet opening at the bottom. As clearly is shown in Figures 1 and 6, the oblong outlet opening does not fall "within" the periphery of the circular inlet opening, but extends beyond, with portions of the interior walls diverging from inlet to outlet.

This is coupled with a downwardly diminishing cross-sectional area from the circular inlet opening to the oblong outlet opening (column 5). Barker discloses a glass feeder apparatus with a single discharge opening rather than the multiple openings found in Kirkman. Barker's spout bowl has a circular inlet opening and an oblong outlet opening, with the outlet opening being "within" the inlet opening, in the manner required by the appellant's claim 1. However, the mere fact that the Kirkman structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Quite frankly, we are unable to appreciate the relevance of the examiner's statement, apparently made to justify the proposed combination of references, that one of ordinary skill in the art would do so because of "the reasonable expectation of providing for the discharge of molten glass from the spout bowl and to control the flow of glass and to deliver a uniform glass gob from the feeder" (final rejection, Paper No. 15, page 5). In any event, it is our view that the artisan would not have been motivated to substitute the Barker arrangement for that disclosed by Kirkman because it would result in a wholesale makeover of the glass discharge spout of Kirkman, and that would appear, in the absence of evidence to the contrary, to destroy the Kirkman invention.

CONCLUSION

Neither rejection is sustained.

The decision of the examiner is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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Appeal No. 1998-0484
Application No. 08/675465

Page 8

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